

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

Fortieth Session
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GRAPHICAL USER INTERFACE (GUI), ICON, TYPEFACE/TYPE FONT DESIGNS: DRAFT QUESTIONNAIRE

Document prepared by the Secretariat

INTRODUCTION

1. It is recalled that, in the framework of the thirty-eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), which was held in Geneva from October 30 to November 2, 2017, an Information Session on Graphical User Interface (GUI), Icon, Typeface/Type Font Designs took place on October 31, 2017.
2. At its thirty-ninth session, which was held in Geneva from April 23 to 26, 2018, the SCT considered two documents prepared by the Secretariat, namely document SCT/39/2 “Summary of the Main Points Emerging from the Information Session on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs” and document SCT/39/3 “Compilation of Proposals by Member States and Accredited Non-governmental Organizations (NGOs) on Aspects of Graphical User Interface (GUI), Icon and Typeface/Type Font Designs” on which further work would be desirable.
3. At the end of that session, the SCT decided that “further work [was] desirable on certain existing issues identified in documents SCT/39/2 and SCT/39/3, in particular on proposals 1, 3, 9 and 10 in document SCT/39/3, while issues related to novel technological designs could be undertaken in a subsequent phase”. Consequently, the SCT requested the Secretariat to “invite Members, Intergovernmental Intellectual Property Organizations with observer status¹ and accredited Non-Governmental Organizations (NGOs) to submit further

¹ *i.e.*, organizations which, under their constituting treaty, have responsibility for the protection of industrial property rights.

inputs, including detailed questions, which they would like to see answered, concerning (1) the requirement for a link between GUIs, Icons, Typeface/Type Font Designs and the article or product and (2) the methods allowed by offices for the representation of animated designs” and “to prepare a draft questionnaire on the basis of the received inputs and questions, for consideration at the SCT at its next session” (see document SCT/39/10, paragraph 9).

4. Accordingly, under Circular letters C. 8775 and C. 8776 of June 11, 2018, the Secretariat invited Member States of the World Intellectual Property Organization (WIPO), the aforementioned Intergovernmental Intellectual Property Organizations with observer status and accredited NGOs to submit further inputs, including detailed questions, concerning the two topics referred to above.

5. At the closing date to reply to that invitation (*i.e.*, on August 20, 2018), the Secretariat had received inputs and questions from the following Member States: Algeria, Australia, Canada, Chile, Georgia, Hungary, Japan, Kazakhstan, Russian Federation, Syrian Arab Republic and United States of America (11). The following Intergovernmental Intellectual Property Organization with observer status replied to the invitation: European Union Intellectual Property Office (EUIPO) (1). The following accredited NGOs also submitted inputs and questions: Intellectual Property Owners Association (IPO), International Chamber of Commerce (ICC), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA) and Japan Trademark Association (JTA) (5).

6. The present document contains a draft questionnaire based on the received inputs and questions². Where applicable, a footnote in a question refers to specific inputs, which illustrate or provide a background to the question concerned.

7. The full text of the submissions is posted on the SCT Electronic Forum webpage at <http://www.wipo.int/sct/en/>.

8. *The SCT is invited to consider the draft questionnaire contained in the present document.*

[Annex follows]

² Questions already covered by the *Questionnaire on Graphical User Interface (GUI), Icon, Typeface/Type Font Designs* circulated on June 10, 2016, by Circular letter C. 8553 have not been included in the present draft questionnaire. The attention of the Committee is drawn to the *Questionnaire on the Electronic Representations of Designs* prepared by the Design Representation Task Force established by the Committee on WIPO Standards (CWS) (see documents CWS/6/29). Questions included in that questionnaire may relate to some of the questions comprised in the present draft questionnaire.

QUESTIONS CONCERNING THE REQUIREMENT FOR A LINK BETWEEN GUI, ICON, TYPEFACE/TYPO FONT DESIGNS AND THE ARTICLE OR PRODUCT³

1. In your jurisdiction, is a link between a GUI, icon, typeface/type font design and an article required as a prerequisite for registration?

YES NO

If **NO**, please proceed to question 10 and the subsequent questions

(a) Requirement for a link

2. In your jurisdiction, for which type of designs is a link with an article required?

- computer-generated animated designs
- GUI designs
- icon designs
- typeface/type font designs
- other – Please specify

3. For which reason is such a link required in your jurisdiction?⁴

- facilitating searches by examining Offices
- facilitating Freedom to Operate (FTO) searches by users
- facilitating searches by applicants
- limiting the scope of design rights
- other - Please specify

4. In your jurisdiction, do functional aspects of the article displaying the GUI, icon, typeface/type font design play a role in assessing the link between such design and the article?

YES NO

If **YES**, what role?

³ For the sake of simplicity, only the term “article” will be used hereafter in the present questionnaire, it being understood that it covers also the term “product”, where applicable.

⁴ See the contributions of Chile, INTA (p. 1-3), IPO (p. 4) and JTA.

5. In your jurisdiction, if a link between a GUI, icon, typeface/type font design and an article is required, but not defined in the design application, can it still be defined during prosecution?

YES NO

If YES, who is empowered to define it?

the applicant
 the Office

6. In your jurisdiction, if a link between a GUI/icon design and an article is required, how can/must the GUI/icon design be represented in the application?

- representation of the GUI or icon design alone + an indication in words of the article
- representation of the GUI or icon design + the article in dotted or broken lines
- representation of the GUI or icon design + the article in dotted or broken lines + an indication in words of the article
- representation of the GUI or icon design + the article in solid lines
- representation of the GUI or icon design + the article in solid lines + an indication in words of the article
- other – Please specify

7. If a design is represented within an article which is disclaimed (e.g., broken lines), the design patent/design registration would be considered to be limited in scope:

- only to the specific type of article that was disclaimed
- to articles that fall within the same classification
- other – Please specify

Is there an exception for GUI/icon designs?

YES NO

8. If a design is represented within an article which appears in solid lines, the scope of the design patent/design registration would be considered to cover:⁵

- only the design
- both the design and the article
- other – Please specify

⁵ See the contributions of INTA (p. 1-2) and IPO (p. 3-4).

9. If a design is represented within an article which is disclaimed (e.g., broken lines) and the identification of the article(s) in relation to which the industrial design is to be used is required, what is the purpose of that identification?

(b) No requirement for a link

10. In your jurisdiction, why is no link between a GUI, icon, typeface/type font design and an article required?⁶

- because of the nature of new technological designs, which may be used in different articles/environments
 other - Please specify

11. If no link is required in your jurisdiction and your Office is an examining Office, does your Office search for GUI/icon designs that apply to all kinds of articles?⁷

YES NO

Please explain

12. If no link is required in your jurisdiction, how do users conduct Freedom to Operate (FTO) searches?⁸

13. If no link is required in your jurisdiction, is the indication of an article:

- optional?
 mandatory?

What is the effect of such indication? Please specify

14. Can a patent design/design registration be obtained for a GUI/icon design *per se* if it is represented alone (without any article such as a screen or a device)?

YES NO

If **YES**, does the patent design/design registration cover use of the claimed GUI/icon design in any article/environment?

YES NO

⁶ See the contributions of Hungary, ICC (p. 2), INTA (p. 3) and IPO (p. 4).

⁷ See the contribution of JTA (p. 7).

⁸ *Idem*.

QUESTIONS CONCERNING THE METHODS ALLOWED BY OFFICES FOR THE REPRESENTATION OF ANIMATED DESIGNS

15. In your jurisdiction, which methods of representation can applicants use to claim protection for animated designs?

Moving images⁹

Please specify the file format (e.g., avi, flv, wmv, wav, mov, mp4):
Please specify the maximum size, if any:

Static images in electronic format

Please specify the file format (e.g., pdf):
Please specify the maximum size, if any:

Static images in paper format

Please specify any additional requirements:

16. Where a choice of different methods of representation is available in your jurisdiction, what method is used the most by applicants?

Moving images

Static images in electronic format

Static images in paper format

17. Are there any additional/special requirements regarding the contents of the application for animated designs?

YES NO

If YES, please specify

18. Where video files can be used by applicants to represent animated designs in your jurisdiction:

video files *only* are accepted

video files + series of static images are mandatory

video files are mandatory + series of static images are optional

video files are optional + series of static images are mandatory

other - Please specify

⁹ The term "images" is used as a synonym of the term "views".

19. Where both series of static images and video files are contained in the application, which format determines the scope of protection?

- both formats, treated equally
- video files prevail and static images are treated just as a reference information - Please specify
- static images prevail and video files are treated just as reference information – Please specify

20. If animated designs are represented by series of static images or a sequence of drawings or photographs, are there additional requirements regarding the images?¹⁰

- YES NO

If YES, is it required that:

- all images relate to the same function of the article
- all images be visually related
- all images give a clear perception of the movement/change/progression
- the number of images does not exceed a maximum number – Please specify
- other – Please specify

21. In which format are animated designs granted?

- paper registration/patent
- electronic (e-grant)
- other

22. In which format are animated designs published?

- paper publication
- electronic publication
- other

23. Are there any special publication procedures for animated designs?

- YES NO

¹⁰ See the contributions of United States of America (p. 3-4), EUIPO (p. 3-5), ICC (p. 3-4), INTA (p. 4), JPAA (p. 4-7), and JTA (p. 9).

ADDITIONAL QUESTIONS

24. In your jurisdiction, are some graphic images excluded from protection under design law?¹¹

YES NO

If YES, which of the following types of images are excluded from protection:

- graphic images representing “contents” that are independent from the function of the article (e.g., a scene of a film or images from a computer/TV game)
- graphic images provided only for decorative purposes (such as a desktop wallpaper)
- graphic images provided only for conveying information
- other – Please specify

If YES, how is the exclusion justified? Please specify

If YES, how are the graphic images subject to protection defined? Please specify

25. In your jurisdiction, are certain kinds of GUI/icon designs excluded from design protection?¹²

YES NO

If YES, please specify

26. In your jurisdiction, is protection provided to designs not embodied in “permanent” articles?¹³

YES NO

If YES, is the design deemed to be embodied in, or tied, to an article?

YES NO

If YES, what is the article?

27. In your jurisdiction, is an indication of the class required in a design application?

YES NO

If YES, which classification system is applied in your Office?

- the Locarno classification
- the domestic classification

¹¹ See the contribution of JTA (p. 5).

¹² See the contribution of JTA (p. 6).

¹³ See the contribution of the United States of America referring, for example, to a water design in a fountain, a laser keyboard and a projection of a speedometer or radio control panel onto a windshield of a car (p. 6).

If **YES**, the class is:

- indicated by the applicant
- assigned by the Office

If the Office assigns the class, can the applicant challenge or appeal the classification?

- YES NO

Is there an exception for GUI/icon designs?

- YES NO

28. Where GUIs are applied to an article, how are they examined in terms of weight given to the visual features where:

- the GUI is the same or similar but applied to different articles in the prior art base
- the article is the same but shown in active/resting state in the prior art base vs. active/resting state in the application
- the article and GUI in the prior art base is the same or similar to one or more but not all of the representations provided showing different stages of the GUI

29. Does your legislation allow for GUIs to be considered in their active state?

- YES NO

If **NO**, is the Office practice to consider them in their active state?

- YES NO

30. In your jurisdiction, are the infringement criteria the same for GUI/icon designs as for other types of designs?

- YES NO

If **NO**, how are they different?

31. In your jurisdiction, which of the following acts constitute infringement of design rights?

- creation of software for displaying a protected GUI
- reproduction of software for displaying a protected GUI
- transfer of software for displaying a protected GUI
- upload of software for displaying a protected GUI
- installation or use of a protected GUI or icon design¹⁴ – In such case, under what circumstances?

¹⁴ See the contribution of IPO referring to indirect infringement doctrines, such as induced infringement (p. 3), and the contribution of JTA (p. 8).

32. In your jurisdiction, can a *single design registration* cover use of the design in a physical environment *and* in a virtual or computer environment?¹⁵

YES NO

33. In your jurisdiction, is there a distinction in the infringement criteria, depending on the particular virtual/electronic environment¹⁶ in which the design is used?

YES NO

If YES, how are the environments delineated?

If YES, would a single design registration be capable of protecting the design in each of these varied environments?

YES NO

34. In what format does your Office provide documents for priority claim purposes?

- paper format
- electronic format
- both

Can the documents be certified?

YES NO

If YES, how are they certified?

Are there any particulars for priority claims concerning animated designs?

YES NO

Please specify

¹⁵ See the examples mentioned in the contribution of the United States of America (p. 6).

¹⁶ e.g., computer game, virtual reality world, Internet application.

35. What format of documents does your Office accept for priority claim purposes?

- paper format
- electronic format
- both

Does your Office require certification of priority documents?

- YES NO

Are there any particulars for priority claims concerning animated designs?

- YES NO

If YES, please specify

[End of Annex and of document]